



Atty. Dkt. No. 034536-0405

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Thomas CIOSSEK, et al.

Title: METHODS FOR DIAGNOSIS AND TREATMENT OF MDK1 SIGNAL TRANSDUCTION DISORDERS

Appl. No.: 10/073,064

Filing Date: 2/12/2002

Examiner: Susan N. Ungar

Art Unit: 1642

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the restriction requirement set forth in the Office Action mailed May 31, 2005, Applicants hereby provisionally elect Group I, Claim 5, drawn to a polypeptide comprising SEQ ID NO:3, for examination. The election is made with traverse.

As a basis for traversal, Applicants submit that the Office has failed to establish a need for the restriction. The criteria for a proper restriction requirement, according to MPEP § 803, are (1) that the inventions must be independent or distinct as claimed, and (2) that there must be a serious burden on the Examiner to examine the entire application. In this case, the Examiner has failed to demonstrate that examination of more than one nucleic acid sequence creates a serious burden.

Indeed, the requirement to elect a single nucleic acid sequence runs counter to the PTO's own policy that "up to ten (10) independent and distinct nucleotide sequences [normally] will be examined in a single application without restriction," to aid the biotechnology industry "without creating an undue burden on the Office." See *Examination of Patent Applications Containing Nucleotide Sequences*, 1192 O.G. 68 (November 19, 1996)

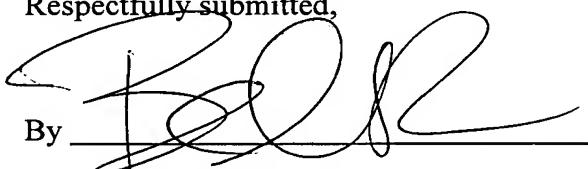
and MPEP 803.04. The Office has failed to articulate any justification for suspending that policy in this case. In particular, the Office has not established that the sequences in this application are any more difficult to examine than those in a "normal" biotechnology case, thereby making it unreasonable to examine more than a single sequence. Indeed, the two restricted sequences in this case share substantial sequence identity, as they represent truncated forms of the same protein.

For these reasons, Applicants respectfully request withdrawal of the restriction requirement.

The Commissioner is hereby authorized to charge any additional fees that may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any extensions fees from Deposit Account No. 19-0741.

Date June 29, 2005

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5475
Facsimile: (202) 672-5399

Respectfully submitted,

By _____
Beth A. Burrous
Attorney for Applicant
Registration No. 35,087